

### **REMARKS**

These Remarks are responsive to the Final Office Action mailed February 25, 2004 ("Office Action"). Applicants respectfully request reconsideration of the rejections of 1-76 for at least the following reasons.

Claims 1-76 are pending in the instant application. Claims 1 and 41 are independent claims. Each of the pending claims stands rejected under 35 U.S.C. § 103(a) over various combinations of references including U.S. Patent 5,826,023 issued to Mary Susan Hall and George James Romano (hereinafter "Hall") and U.S. Patent in view of U.S. Patent 5,212,792 issued to M. Colin Gerety *et al.* (hereinafter "Gerety"). Claims 1, 2, 4, 17, 19, 20, 23, 28-34, 36-42, 44-46, 59, 60, 63, and 68-76 stand rejected as being unpatentable over Hall in view of Gerety. Claims 3 and 43 stand rejected as being unpatentable over Hall in view of Gerety and further in view of an IBM Technical Bulletin titled "Shared Directory." Claims 5-16, 18, 35, 47-52 and 54-58 stand rejected as being unpatentable over Hall in view of Gerety and further in view of U.S. Patent 6,470,357. Claims 21-22 and 61-62 stand rejected as being unpatentable over Hall and Gerety and further in view of Japanese Patent Publication 11078891. Claims 24, 25, 64, and 65 stand rejected as being unpatentable over Hall and Gerety and further in view of Japanese Patent Publication 01064037. Claims 26, 53, and 66 stand rejected as being unpatentable over Hall in view of Gerety and further in view of Japanese Patent Publication 59146347. Claims 27 and 67 stand rejected as being unpatentable over Hall and Gerety and further in view of Japanese Patent Publication 1107326.

The Office Action rejects the independent claims, claims 1 and 41, over Hall in view of Gerety. This combination of references fails to show or suggest each limitation of either claim 1 or 41. In addition, there is no suggestion to combine Hall and Gerety in the manner set forth in the Office Action.

Hall is directed to communications tunneling. Hall describes encapsulating messages prepared in first format as a database object in a second format. The database object is distributed through a network designed to transmit objects of the second format.

Gerety is directed to a tool integration platform that permits various software program modules call one another. The tool integration platform includes a message server, which provides means for communication between tools.

Claim 1 sets forth a method of conveying a message. The method includes three steps. The applied references fail to teach or suggest these any of the three steps of claim 1.

Claims 1 includes a step of generating a first service identifier associated with a second application. The Office Action acknowledges that the primary reference to Hall does not teach such a first service identifier. Gerety is relied on to show the first service identifier. However, a rejection under 35 U.S.C. § 103(a) should set forth the proposed modification of the applied references necessary to arrive at the claimed subject matter. The Office Action merely asserts that Gerety teaches a first service identifier. There is no explanation in the Office Action how to modify the primary reference to Hall based on the teaching of Gerety to arrive at the claimed subject matter.

Hall is directed to sending email created by standard client using POP3/MIME protocols through an IBM SNADS networks. Hall, col. 1, ll. 34-37. In Hall no conversion takes place. Hall, col. 2, ll. 45-62. For example in Hall, POP3/MIME clients move mail through a SNADS network to other POP3 clients. As acknowledged in the Office Action, Hall does not teach a first service identifier associated with a second application. There is simply no function for such a first service identifier to fill in the Hall system.

In Gerety, software tools communicate with other software tools in the system via messages sent to the message server. Gerety, col. 6, ll. 8-10. The messages have a format that is divided into seven fields. Gerety, col. 7, ll. 7-8. One of the seven fields is the "Tool Class" field, which indicates the type of tool the message is destined for. Gerety, col. 7, ll. 49-52. There is no explanation how the Hall system directed to the transmission of email messages of standard formats could be modified to use the "Tool Class" field of Gerety. As there is no explanation how to modify the references to arrive at the claimed subject matter, the Office Action does not set forth a *prima facie* case of obviousness.

Furthermore, to establish a *prima facie* case of obviousness there must be some suggestion or motivation to combine the reference teachings. The Office Action merely identifies features from two disparate references. There is no suggestion to combine the identified features.

The Office Action at page 3 states, “It would have been obvious . . . to combine the teaching of Hall and Gerety because Gerety’s type of tool the message is destined for would select the recipient software tools for transferring the message.” The Office Action misstates the function of the “Tool Class” message of Gerety. Gerety does not suggest that the “Tool Class” message selects the software for transferring the message. To the contrary, Gerety describes that the tools to receive each message are determined by a pattern-matching facility. Gerety, col. 8, ll. 12-13. Each tool registers in advance the types of messages that it wishes to receive. Gerety, col. 8, ll. 13-16. Accordingly, the “Tool Class” message does not select the recipient software tools as implied in the Office Action.

Even if accurate, the statement on page 3 of the Office Action fails to provide a motivation to combine the teaching of Gerety with the Hall system. The statement refers to selecting recipient software tools. Hall is not directed to the management of software tools. There is no suggestion to select any software tool of Hall to transfer any message. The Office Action merely attempts to set forth a function of a feature taught by Gerety. The Office Action fails to set forth how the prior art suggests combining such a function with the teaching of Hall. Accordingly, the Office action has failed to establish a *prima facie* case of obviousness.

Claim 1 sets forth that a first set of parameters is required by a transport infrastructure to transmit the message from a first application to the second application. The Office Action relies on a tunnel-to attribute and recipient e-mail address of Hall to show the first set of parameters. Claim 1 includes the step of retrieving the first set of parameters from a first directory using the first service identifier. The Office Action relies on retrieving information from directory 304 of Hall to show this step.

As Hall fails to show or suggest a first service identifier, Hall does not show or suggest retrieving the first set of parameters using the *first service identifier*. In Hall, the tunnel-to

attribute for a recipient e-mail address is located in address directory 304. Hall, col. 5, ll. 64-67. No service identifier is used in Hall to retrieve a set of parameters. There is no suggestion how the "Tool Class" field of Gerety, relied upon to show a first service identifier, could be used to retrieve a set of parameters from the address directory of Hall. Accordingly, the applied art fails to show or suggest the step of retrieving as set forth in claim 1.

Claim 1 also includes a step of passing the message and the retrieved set of parameters to the transport infrastructure. The Office Action relies on the first protocol and SNADS routers of Hall to show the transport infrastructure. As noted above, the Office Action relies on the tunnel-to attribute from the address directory of Hall to show the retrieved set of parameters. Hall does not show or suggest passing the tunnel-to attribute to the SNADS routers or the Office Vision/400 protocols. To the contrary, a tunnel program is invoked to perform MIME message encapsulation required to tunnel through the SNADS network. Hall, col. 6, ll. 34-36. The tunnel program creates, as part of a SNADS message, an object distribution function format message that includes an object distribution control block. Hall col. 6, ll. 36-41. The created message appears just as any SNADS message. Accordingly, the SNADS routers and associated protocols simply receive a message with a MIME message encapsulated as an object. No set of parameters, as set forth by claim 1, is passed to the SNADS routers as implied in the Office Action. Accordingly, the applied art fails to show or suggest the step of passing as set forth in claim 1.

The Office Action notes that claim 41 is an apparatus claim of claim 1 and is therefore rejected for the same reason as claim 1. Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of obviousness against claim 41 for at the reasons discussed above with regard to claim 1. The applied art fails to show or suggest a sending module receiving a first service identifier from a first application, where the first service identifier is associated with a second application. The applied art fails to show or suggest a first directory containing a first set of parameters, where the first set of parameters is required by the transport mechanism to transmit the message. The applied art also fails to show or suggest a sending module that retrieves the first set of parameters from the first directory in response to receipt of

the first service identifier. The applied art fails to show or suggest a sending module that passes the retrieved first set of parameters to the transport mechanism.

The remaining claims depend from claims 1 and 41 and are rejected on the basis of Hall in view of Gerety and, in the case of some claims, further in view of various other references. Applicant respectfully submits that these dependent claims are patentable over Hall in view of Gerety for at least the reasons set forth above with respect to claim 1. The additional applied references fail to cure the deficiencies of the combination of Hall and Gerety. Accordingly, the Office Action fails to establish a *prima facie* case of obviousness against dependent claims 2-40 and 42-76.

Applicant respectfully requests reconsideration and further examination of this application in view of the above remarks. Applicant has addressed every ground of rejection in the Office Action and submits that all pending claims are patentably distinguishable over the prior art of record, taken in any proper combination. The Examiner is invited to telephone the undersigned Applicant's representative to resolve any issues that may expedite the prosecution of this application.

Respectfully submitted,

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